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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,066	03/31/2004	Katja Peter	RECP:110US	7865
7590 08/01/2005			EXAMINER	
Michael L. Dunn Simpson & Simpson, PLLC 5555 Main Street Williamsville, NY 14221			ROBINSON, MARK A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/815,066	Applicant(s) PETER ET AL.	
	Examiner Mark A. Robinson	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 8-11 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Drawings***

The drawings are objected to because fig. 1 contains text not in the English language. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office

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action. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 1-17 are objected to because of the following informalities. Appropriate correction is required.

In claim 1 the first rotating element is said to have a larger diameter than the second rotating element. Claim 1 further calls for the step, which is a part of the second element, to have a diameter approximately the same as that of the first element. Thus, the language of this claim should be changed to reflect that the first element has a larger diameter than that of the portion of the second element excluding the step.

In claim 13 "the envelope surface of the first rotating element" lacks antecedent basis.

In claim 16 "the optical system" lacks antecedent basis.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Otomo (US 6064519).

Otomo discloses an operating knob for a microscope including first(12) and second(10) independently rotatable coaxial elements, each including at least a partly conical form (note element 10 in fig. 4 and element 12 in figs. 3 and 4), with the first element having a larger diameter than the second element, the second element(10) having a step (see fig. 3) formed at the side opposing the first element(12), the step having a diameter approximately the diameter of the first element and forming a groove between the first and second elements (see fig. 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 3,5-7,14,15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo.

Regarding claims 3 and 17, Otomo shows grooves on the first element (see fig. 1) but not also on the second element(10). However, Otomo's prior art fig. 8 shows grooves on both of these elements(50,52). It would have been obvious to the ordinarily skilled artisan at the time of invention to use grooves on both of these elements in order to improve a user's grip when turning these elements.

Regarding claims 5-7, Otomo shows the first element to have cylindrical and conical portions but not the second element. Further, Otomo does not show the angle such conical portions make with the rotation axis to be between 5 and 10 degrees (or 7 degrees, specifically). However, Otomo shows the second element(10) to include a conical portion having an angle with the rotation axis which the examiner measures to be about 7 degrees (see fig. 4). Making Otomo's second element to have both cylindrical and conical portions like his first element (fig. 4 item 12), and making the angle of the conical portions to be 7 degrees as shown in fig. 4 would have been obvious to the ordinarily skilled artisan at the time of invention in order to provide the microscope with ergonomic focusing knobs.

Regarding claims 14 and 15, although not taught by the reference, both polymer and stainless steel are commonly used to make control knobs. It would have been obvious to the ordinarily skilled artisan at the time of invention to use either of these materials for Otomo's knobs since the materials are readily available and provide the advantages of light weight and corrosion resistance, respectively.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo in view of Yamamoto (US 6512632).

Otomo does not teach a rubber inlay on the surfaces of the rotating elements. However, such is taught by Yamamoto (see col. 7 line 65). It would have been obvious to the ordinarily skilled artisan at the time of invention to use rubber inlays on Otomo's rotating elements in order to improve the user's grip when turning the rotating elements.

Allowable Subject Matter

7. Claims 8-11 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Note that any objections set forth above must also be overcome.

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8. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest the dimensions for the rotating elements set forth in the combination of claim 8 or the cooperating cone-shaped surfaces for the first and second elements as set forth in the combination of claim 13.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Esmay and Clark show knobs wherein the second element has a step with approximately the same diameter as the first element. Shimokawa shows a microscope with conic-shaped first and second rotating elements (see fig. 4).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

7/29/05


MARK A. ROBINSON
PRIMARY EXAMINER